

### **REMARKS/ARGUMENTS**

Entry of the foregoing and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested.

By the foregoing amendment, claims 1-9, 13, 17, 21-24 and 26-28 have been canceled without prejudice or disclaimer of the subject matter recited therein. New claims 29-35 have been added. No new matter has been added.

#### **I. Priority**

Applicants submit herewith a certified copy of Japanese Application No. 10/283301.

#### **II. Rejections Under 35 U.S.C. § 102**

Claims 1-9, 13 and 21-23 have been rejected under 35 U.S.C. § 102(b) as allegedly begin anticipated by Lonsky et al. (U.S. Patent No. 5,747,233). This rejection is rendered moot in light of the cancellation of claims 1-9, 13, 17, 21-24 and 26-28. However, to the extent that this rejection may apply to new claims 29-35, it is respectfully traversed.

Lonsky et al. is related to dyes having a general formula as set forth in column 1 of the patent. This reference does not teach or suggest compounds where R1 and R2 (corresponding to R19 and R20 of the instant application) are alkyls with 1-5 carbon atoms and are substituted by a sulfonic acid group.

Therefore, applicants respectfully request withdrawal of this rejection.

Claims 1-9, 13, 17 and 21-23 have been rejected under 35 U.S.C. § 102(b) as allegedly begin anticipated by Ohno et al. (U.S. Patent No. 4,839,266). This rejection is rendered moot in light of the cancellation of claims 1-9, 13, 17, 21-24 and 26-28. However, to the extent that this rejection may apply to new claims 29-35, it is respectfully traversed.

Ohno et al. is related to photosensitive materials containing a dye of formula I (column 3) of the patent. This reference does not disclose the sodium salts instantly claimed. The examples cited by the Examiner (Example 7, column 5-6 and example 13, column 7-8 of Ohno et al.) are potassium salts. Further, example 7 of Ohno et al. does not have an alkyl

substitution at L4 as recited in claim 29. Therefore, applicants respectfully request withdrawal of this rejection.

Claims 1-9, 21-24 and 26-28 have been rejected under 35 U.S.C. § 102(e) as allegedly begin anticipated by Licha et al. (U.S. Patent No. 6,258,340) or Randall et al. (U.S. Patent No. 6,114,350). This rejection is rendered moot in light of the cancellation of claims 1-9, 13, 17, 21-24 and 26-28. However, to the extent that this rejection may apply to new claims 29-35, it is respectfully traversed.

Licha et al. and Randall et al. are related, *inter alia*, to dyes having a general formula as set forth in the patents. Like Lonsky et al., these references does not teach or suggest compounds where R11 and R12 (corresponding to R19 and R20 of the instant application) are alkyls with 1-5 carbon atoms and are substituted by a sulfonic acid group.

Therefore, applicants respectfully request withdrawal of this rejection.

### **III. Rejections Under 35 U.S.C. § 103**

Claims 1-9, 21-24 and 26-28 have been rejected under 35 U.S.C. § 103(a) as allegedly begin unpatentable over Ohno et al. in view of WO 98/22146 or Licha et al. This rejection is rendered moot in light of the cancellation of claims 1-9, 13, 17, 21-24 and 26-28. However, to the extent that this rejection may apply to new claims 29-35, it is respectfully traversed.

Applicants submit that the cited reference does not disclose the claimed sodium compounds. Further, there is no motivation to replace potassium ( $K^+$ ) in Ohno et al. with sodium ( $Na^+$ ). Without such motivation, a prima facie case of obviousness has not been established. *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992).

Therefore, applicants respectfully request withdrawal of this rejection.


In view of the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order. Such action is earnestly solicited.

In the event that there are any questions relating to this application, it would be appreciated if the Examiner would telephone the undersigned attorney or agent concerning such questions so that prosecution of this application may be expedited.

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Attorney Docket No.: SCH-1799  
Reply Dated April 18, 2003  
Reply to Office Action of December 18, 2002

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

  
\_\_\_\_\_  
Anthony J. Zelano, Reg. No. 27,969  
Attorney for Applicant(s)  
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Nicole E. Kinsey, Reg. No. 50,723  
Agent for Applicant(s)

MILLEN, WHITE, ZELANO  
& BRANIGAN, P.C.  
Arlington Courthouse Plaza 1, Suite 1400  
2200 Clarendon Boulevard  
Arlington, Virginia 22201  
Telephone: (703) 243-6333  
Facsimile: (703) 243-6410

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